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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/087,753 | 03/05/2002 | Yoshimi Ishikawa | 0505-0973P | 1779 |
| 2292 | 7590 | 04/09/2004 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | TENTONI, LEO B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1732 | |
| DATE MAILED: 04/09/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary

Application No.

10/087,753

Applicant(s)

ISHIKAWA ET AL.

Examiner

Leo B. Tentoni

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-18 is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/651,118.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>03052002</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1732, Examiner Leo Tentoni.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/651,118, filed on 30 August 2000.

Specification

3. The disclosure is objected to because of the following informalities: On page 1, the status of the parent application should be updated.

Appropriate correction is required.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: PROCESS OF MAKING A DISC BRAKE PISTON SEAL MEMBER.

Claim Interpretation

5. Independent claims 11, 16 and 19 recite, as a preamble, "[a] method for manufacturing a disc brake piston seal member". A claim preamble must be read in the context of the entire claim, and the determination of whether preamble recitations are structural limitations or mere statements of purpose or use can

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only be resolved on review of the entire record to gain an understanding of what the inventors actually invented and intend to encompass by the claim (Corning Glass Works v. Sumimoto Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)). In the instant application, the claim preamble (of independent claims 11, 16 and 19) is not considered a limitation and is of no significance to claim construction because the body of these claims fully and intrinsically set forth all of the limitations of the claimed invention, and the preamble merely states the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations (Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 60-141779-A.

Japan 60-141779-A (see the entire document, in particular, Figures 1 and 2, and the attached English-language abstract) teach a process of making a seal member (for a bearing) including the steps of providing a cylindrical seal material (e.g., a fluorine rubber) of an indeterminate length, having inner and outer circumferential surfaces and cutting the seal material into ring pieces for manufacturing seal members (for a bearing). Japan 60-141779-A specifically teaches manufacturing bearing seal members, and does not specifically teach manufacturing piston seal members. However, manufacturing piston seal members would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Japan 60-141779-A principally because a seal member for a bearing (a part in which another part (e.g., journal, pin) slides or turns) functions in a manner similar to that of a seal member for a piston (a sliding piece fitting within a cylindrical type of vessel) and one of ordinary skill in the art (of manufacturing seal members) would

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have a reasonable expectation of success in manufacturing piston seal members using the process of Japan 60-141779-A (In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988)).

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (Japan 60-120041-A).

Sato (see the entire document, in particular, Figure 1, and the attached English-language abstract) teaches a process of making a seal member (for a bearing) including the steps of providing a cylindrical seal material of an indeterminate length, having inner and outer circumferential surfaces and cutting the seal material into ring pieces for manufacturing seal members (for a bearing). Sato specifically teaches manufacturing bearing seal members, and does not specifically teach manufacturing piston seal members. However, manufacturing piston seal members would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Sato principally because a seal member for a bearing (a part in which another part (e.g., journal, pin) slides or turns) functions in a manner similar to that of a seal member for a piston (a sliding piece fitting within a cylindrical type of vessel) and one of ordinary skill in the art (of manufacturing seal members) would have a reasonable expectation of success in manufacturing piston seal members using the process of Sato (In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988)).

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Allowable Subject Matter

10. Claims 11-18 are allowable over the prior art references presently of record.

11. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art references, alone or in combination, disclose, suggest or teach a process of making a piston seal member including the step of coating an inner circumferential surface of a cylindrical seal material with a friction reducing agent (as set forth in instant independent claim 11), or including the step of performing a chemical friction reduction process on the inner circumferential surface of a cylindrical seal material (as set forth in instant independent claim 16).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 4,723,350 teaches a process of making an oil seal, but does not teach coating or chemically treating an inner circumferential surface of a cylindrical seal material. Japan 60-120042-A is similar to Japan 60-120041-A. Japan 63-160811-A teaches a process of making seal rings including the step of completely coating a rubber ring with a fluorine plastic layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (571) 272-1209. The examiner

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can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leo B. Tentoni

Leo B. Tentoni
Primary Examiner
Art Unit 1732

lbt